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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,173	12/02/2005	Federico Pavan	07040.0230	8050
22852 7590 05/07/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER	
			CRANE, DANIEL C	
			, ART UNIT	PAPER NUMBER
	,		3725	
,			MAIL DATE	DEL WERV MODE
				DELIVERY MODE
			05/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/537,173	PAVAN ET AL.
Office Action Summary	Examiner	Art Unit
	Daniel C. Crane	3725
The MAILING DATE of this communication a Period for Reply	appears on the cover sheet w	ith the correspondence address
• •	DIVIC CET TO EVOIDE AN	IONITU(C) OR TURREY (20) DAVC
A SHORTENED STATUTORY PERIOD FOR REI WHICHEVER IS LONGER, FROM THE MAILING  - Extensions of time may be available under the provisions of 37 CFR after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory per Failure to reply within the set or extended period for reply will, by sta Any reply received by the Office later than three months after the material patent term adjustment. See 37 CFR 1.704(b).	DATE OF THIS COMMUNI 1.136(a). In no event, however, may a iod will apply and will expire SIX (6) MON tute, cause the application to become A	CATION. reply be timely filed  YTHS from the mailing date of this communication. BANDONED (35 U.S.C. § 133).
Status		
1) Responsive to communication(s) filed on		·.
	his action is non-final.	
3) Since this application is in condition for allow	wance except for formal mat	ters, prosecution as to the merits is
closed in accordance with the practice unde		-
Disposition of Claims	, .	
4)⊠ Claim(s) <u>32-62</u> is/are pending in the applica	tion	
4a) Of the above claim(s) is/are without the application of the above claim(s) is/are without the application of the above claim(s) is/are without the application of		
5) Claim(s) is/are allowed.	mawn nom consideration.	•
6)⊠ Claim(s) <u>32-62</u> is/are rejected.		
7) Claim(s) is/are objected to.		
8) Claim(s) are subject to restriction and	d/or election requirement.	
Application Papers		
9) The specification is objected to by the Exam	inas	
10) The drawing(s) filed on is/are: a) a		by the Evaminer
Applicant may not request that any objection to t		
Replacement drawing sheet(s) including the corr	- · ·	` '
11) The oath or declaration is objected to by the	_	
Priority under 35 U.S.C. § 119		
<u> </u>	ian priority under 25 U.C.O. (	C 110(a) (d) ar (f)
12) Acknowledgment is made of a claim for fore a) All b) Some * c) None of:	igh phonty under 35 U.S.C. (	3 113(a)-(u) or (t).
1. Certified copies of the priority docume	ents have been received	
2. Certified copies of the priority docume		Application No.
3 🛛 Copies of the certified copies of the p		
application from the International Bur	eau (PCT Rule 17.2(a)).	·
* See the attached detailed Office action for a l	ist of the certified copies not	received.
Attachment(s)		
Attachment(s)  Notice of References Cited (PTO-892)	4) Interview 9	Summary (PTO-413)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(	s)/Mail Date
B) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>6/1/2005</u> .	5)  Notice of I	nformal Patent Application

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### BASIS FOR REJECTIONS

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

#### REJECTION OF CLAIMS OVER PRIOR ART

Claims 60-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerspacher (4,143,209). See claim 9-12 where the metal wire of steel having a brass coating can be made into a plurality of wires that are stranded together to form a cord or cable (see also column 3, lines 31-55, of Gerspacher). Thus, the final product is shown by the prior art.

[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted) (Claim was directed to a novolac color developer. The process of making the developer was allowed. The difference between the inventive process and the prior art was the addition of metal oxide and carboxylic acid as separate ingredients instead of adding the more expensive pre-reacted metal carboxylate. The product-by-process claim was rejected because the end product, in both the prior art and the allowed process, ends up containing metal carboxylate. The fact that the metal carboxylate is not directly added,

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but is instead produced in-situ does not change the end product.) See MPEP 2113.

Claims 60-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawada (4,859,822). See Figure 3 where the metal wire 101 has a metal core 201 and a coating 103. A plurality of wires can be placed together and stranded together (see Example 6). See the above comments relating to the product made by the process.

Claims 32-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerspacher (4,143,209) in view of Sawada (4,859,811). Gerspacher discloses at column 2, lines 15-39) the basic claimed method of forming a coated metal wire by thermally treating the metal core, submitting the core t a surface treatment (cleaning/pickling/water rinsing) to prepare the core for coating, coating the metal core with a metal coating and drawing the metal-coated metal core to reduce the diameter of the coated core to a finely coated wire. The metal core initially has a diameter of 0.9 to 1.4 millimeters and the final diameter of the coated wire is in the range of 0.08 to 0.40 millimeters. In light of this large reduction in diameter of the wire from its initial size to it final size, it is evident that the final wire will have a smaller coating thickness than originally provided and a smaller core diameter than originally provided. While Gerspacher uses an electroplating process for obtaining the adhesion of the coating to the core, it is common in this art to use other coating provisions that facilitate greater adhesion advantages. Sawada shows a plasma deposition to be commonly used for this purpose. Accordingly, it would have been obvious to the skilled artisan at the time of the invention to have modified Gerspacher's coating process by using a plasma or sputtering deposition process for the above noted motivation. The speed would have been selected based upon available hardware and desired finishing outcomes.

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This has not been disclosed as a critical provision. The manner of drying, i.e., by a blower, would have been within the purview of the skilled artisan. Claim 40 is considered inherently performed by Sawada's plasma CVD or chemical vapor deposition or sputtering vapor phase method (see Sawada at column 3, lines 26-33). Similarly, the pressures would have been obvious ranges barring any critical features. Sawada shows two coating chambers at 14. Descaling is commonly performed in the coating art to provide a clean surface for the coating. As to the different dimensions, i.e., thickness, diameters, it is the examiner's position that Gerspacher teaches the basic dimensional variations in the initial and final shaping operations by virtue of the fact that the core is coated with a predetermined thickness that results in a finely coated wire having a final diameter of 0.25 mm (see column 4, lines 21-23).

### PRIOR ART CITED BY EXAMINER

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

## **RESPONSE BY APPLICANT(S)**

Applicant(s) response to be fully responsive and to provide for a clear record must specifically point out how the language of the claims patentably distinguishes them from the references, both those references applied in the objections and rejections and those references cited in view of the state of the art in accordance with 37 CFR 1.111 (a), (b) and (c).

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**INQUIRIES** 

Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to Examiner D. Crane whose telephone number is (571) 272-4516.

The examiner's office hours are 7:00AM-3:30PM, Monday through Friday. The examiner's

supervisor, Derris Banks, can be reached at (571) 272-4419.

Documents related to the instant application may be submitted by facsimile transmission

at all times to Fax number (571) 273-8300. Applicant(s) is(are) reminded to clearly mark any

transmission as "DRAFT" if it is not to be considered as an official response. The Examiner's

Fax number is (571) 273-4516.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DCCrane

April 25, 2007

Daniel C. Crane

Primary Patent Examiner

Group Art Unit 3725